

REMARKS

Claims 1-23 are pending in the application. Claims 1, 2, 6, 7, 11, 13-15, 17, 19, 21, 22 have been amended. Claims 12 and 18 have been cancelled. No new matter has been introduced. Acceptance is respectfully requested.

35 U.S.C. § 101 Rejection

Claims 1-23 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter because the claimed invention is in violation of the CAN-SPAM Act of 2003 (Controlling the Assault of Non-Solicited Pornography and Marketing Act).

According to M.P.E.P. 2107.01, “to satisfy the requirements of 35 U.S.C. 101, an applicant (1) must claim an invention that is statutory subject matter and (2) must show that the claimed invention is ‘useful’ for some purpose either explicitly or implicitly.” Courts have given the labels “practical utility,” “substantial utility,” or “specific utility” to the “useful invention” requirement of 35 U.S.C. 101. In *Nelson v. Bowler*, the Court of Customs and Patent Appeals has stated: “Practical utility is a short hand way of attributing ‘real-world’ value to claimed subject matter. In other words, one skilled in the art can use a claimed discovery in a manner which provides some immediate benefit to the public.” 626 F.2d 853, 856 (CCPA 1980). The USPTO must rely on the inventors understanding of her invention in determining whether an invention is a “useful invention.” M.P.E.P. 2107.01. As a result, “[o]ffice personnel should focus on and be receptive to assertions made by the applicant that an invention is ‘useful’ for a particular reason.” M.P.E.P. 2107.01.

Applicants provide a method and system for automatically generating an e-mail address of a person named in a database for whom e-mail address information is missing. According to the method and system, potential e-mail addresses for the person are deduced based on the format of the working e-mail addresses. Once the potential e-mail addresses have been constructed, they are verified by sending a test e-mail to each of the constructed potential e-mail addresses.

First of all, Applicants’ claimed invention is directed to statutory subject matter because it is a process, i.e., the claims require “one or more acts to be performed”. M.P.E.P.2106(IV)(2)(b).

Moreover, Applicants' claimed process is statutory because "it results in a physical transformation outside the computer." 2106(IV)(2)(b).

The second and last requirement under 35 U.S.C. 101 is that the claimed invention be useful. Applicants' invention is clearly a useful invention - otherwise unknown e-mail addresses are constructed and verified. Even though the CAN-SPAM Act of 2003 as presented in the Office Action appears to prohibit practicing the claimed invention, embodiments of the claimed invention meet the requirements of this law. The CAN-SPAM Act of 2003 covers electronic mail messages whose primary purpose is advertising or promoting a commercial product or service. Base Claims 1 and 6 are not directed to e-mail messages at all, commercial or otherwise, rather Claims 1 and 6 are directed to e-mail addresses and stop short of sending e-mail whose primary purpose is advertising and promoting. Similarly base claims 11 and 17 are not directed to e-mail messages but rather the mining of information on people and organizations.

Dependent claims 2, 7, 15 and 22 recite the step of verifying e-mail addresses by testing each. Such verifying (testing) does not have and is not equivalent to having a primary purpose of advertising or promoting a commercial product, service or website content as required by the CAN-SPAM Act of 2003.

As to address harvesting and dictionary attacks, the subject Act at Section 5(b)(1) states that "it is unlawful for any person...to assist in the origination of such message through the provision or selection of addresses..., if such person had actual knowledge, or knowledge fairly implied... that... (ii) the electronic mail address of the recipient was obtained using an automated means that generates possible electronic mail addresses..."

The present invention as claimed does not provide or select addresses which assist in the origination of spam messages. The claimed invention stops short of specifying to whom the generated e-mail addresses are provided for use and how those generated e-mail addresses are subsequently used. The user of the claimed invention is not recited to assist in the origination of spam messages (or any messages) through the provision or selection of addresses generated by the claimed steps/system. In fact the claimed invention is just as usable by a sender of non-commercial messages such as messages about candidates for public office or by a company sending messages about the status of an existing account that the receiver has with the company.

Each of these types of e-mail are not covered by the subject Act (i.e., are not unlawful according to the Act).

Assuming *arguendo* that embodiments of the claimed invention are used to send commercial e-mail messages, such embodiments comply with the CAN-SPAM Act of 2003 where a return e-mail address or some other internet-based mechanism is included to allow the recipient to send a reply or other form of internet-based communication to request that he not receive future e-mail messages. CAN-SPAM Act of 2003, Section 5(a)(3)(A). Moreover, such uses of embodiments of Applicants' invention comply with the CAN-SPAM Act if the subject message provides: (1) an identification that the message is an advertisement or solicitation, (2) a notice of the opportunity to decline further messages from the sender, and (3) a valid physical postal address of the sender. CAN-SPAM Act of 2003, Section 5(a)(5)(A).

For the foregoing reasons, the claimed constructing and verifying potential e-mail addresses or the mining of information of people or organizations is useful and complies with the requirements (i.e., are not literally or necessarily in violation) of the CAN-SPAM Act of 2003. Thus the requirements of §101 are met and this rejection of the claims should be withdrawn.

35 U.S.C. § 102 Rejections

Claims 11 and 17 have been rejected under 35 U.S.C. 102(e) as being anticipated by Knight *et al.* (U.S. Patent No. 6,493,703) ("Knight").

Knight provides an electronic message board system that may include a message management system, a tracking system and/or a content building system (Column 7, lines 18-20). The message management system includes a content storing routine and a query handling routine (column 5, line 49 to column 6, line 24). The content sorting routine sorts and stores electronic messages by category. The query handling routine locates a selected set of electronic messages in response to a user's query. The tracking system monitors message content traffic from the subscribers and other sources (column 6, lines 25-39). This information may be used to modify the user interface, to determine new areas for content extraction, to add or modify classifications, etc.

The content building system builds a database of information by locating, extracting and sorting information from remote servers based on criteria specified by the message board system operator (column 6, lines 40-59).

Independent Claims 11 and 17 have been amended to include the limitations from dependent Claims 12 and 19, respectively, relating to combining database records. In the Office Action at page 7, paragraph 29, the Examiner states that “Knight fails to disclose combining database records of information.” Therefore, Applicants respectfully request that the rejections of Claims 11 and 17 be withdrawn.

35 U.S.C. § 103 Rejections

Claims 1 and 6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henric, *et al.* (U.S. Patent No. 6,377,936)(“Henrick”) in view of Miller (On-line Search Secrets, 173-179).

In the Office Action at page 4, paragraph 8, the Examiner correctly summarizes Miller as teaching “well-known techniques for finding e-mail address information on the web” (emphasis added). Independent Claims 1 and 6 have been amended to clarify that Applicants’ invention does not find or search for e-mail addresses on the web, but instead automatically constructs and verifies potential e-mail addresses of a person named in a database who does not have e-mail address information. Since Miller does not teach, suggest or otherwise make obvious each and every limitation of independent Claims 1 and 6 as now amended (“digital processor means coupled to the database . . . automatically constructing and verifying potential e-mail address of a subject person named in the database but for whom e-mail address information is missing”), Applicants respectfully request that the rejection of Claims 1 and 6 be withdrawn.

Dependent Claims 4 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller and further view of Mills (Australian Patent Abstract No. AU-A-53031/98). Mills does not add to Henrick automatically constructing and verifying potential e-mail addresses. Since Claims 4 and 9 depend from base Claims 1 and 6, respectively, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

Claims 5 and 10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Mills as applied to Claim 4 and in view of Barroux (U.S. Patent No. 5,923,850).

As explained above, Henrick does not teach, suggest or otherwise make obvious each and every limitation of base Claims 1 and 6. Barroux does not add to Mills and Henrick automatically constructing and verifying potential e-mail addresses. Since Claims 5 and 10 depend from base Claims 1 and 6, respectively, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

Claims 2-3 and 7-8 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller, in view of Biliris *et al.* (U.S. Pub. No. 2001/0009017) (“Biliris”).

Biliris provides a messaging system that “supports combinations of directory and mailing list addressing mechanisms, provides the capability to specify intended message recipients using combinations of mailing lists and directory information, and does not require mailing lists to be explicitly enumerated.” Biliris, paragraph 9.

A messaging process of the messaging system is shown in Fig. 2A of Biliris. In step 202, a user inputs a message and a declarative address. A declarative address specifies “an intended set of recipients based on their properties” or other information. Biliris, paragraph 33. If necessary, in step 203, the messaging system generates the declarative address based on the information input by the user. In step 204, the declarative address is transmitted to a messaging server. In step 206, an address resolution module translates the declarative address into a query compatible with a back-end database system. The query is then sent to the back-end database system. In step 208, a query evaluation block of the back-ended database system accesses a database to retrieve the information requested by the query. “The retrieved information is a list of the messaging addresses of all users who satisfy the selection parameters specified by the declarative address . . .” Biliris, paragraph 30. In step 210, the messaging system transmits the message to all the addresses included in the retrieved list of messaging addresses.

Base Claim 1 as now amended, from which Claim 2 depends, recites automatically constructing and verifying potential e-mail addresses of a subject person named in the database but for whom e-mail information is missing from the database. Biliris does not teach, suggest or otherwise make obvious automatically constructing and verifying potential e-mail addresses that

are missing from a database. Biliris instead teaches resolving declarative address into e-mail addresses by querying a database of records having known e-mail addresses. In summary, the Biliris messaging system can only send messages to persons for whom e-mail address information exists in their database records.

As explained above, Henrick and Mills, alone or in any combination, do not teach, suggest, or otherwise make obvious each and every limitation of independent Claims 1 and 6. Biliris does not add to Mills and Henrick the automatically constructing and verifying potential e-mail addresses of a subject person named in the database but for whom e-mail address information is missing from the database. Since Claims 2-3 and 7-8 depend from base Claims 1 and 6, respectively, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn for at least the same reasons. Claims 2 and 7 have been amended to be consistent with the amendments to base claims 1 and 6.

Claim 12 has been rejected under 35 U.S.C. 103(a) as being unpatentable overnight in view of Feridun *et al.* (U.S. Patent No. 6,336,139) ("Feridun"). Claim 12 has been cancelled.

Dependent Claim 13 has been amended to depend from now amended base Claim 11. Amended claim 19 and claim 20 depend from now amended base claim 17. As explained above, Knight does not teach, suggest or otherwise make obvious each and every limitation of independent Claims 11 and 17. Since Claims 13 and 19-20 depend from base Claim 11 and 17, respectively, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

Claim 18 has been cancelled.

Claims 14 and 21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Knight and Henrick.

As explained above, Knight and Henrick, alone or in any combination, do not teach, suggest or otherwise make obvious each and every limitation of now amended independent Claims 11 and 17. Since Claims 14 and 21 depend from independent Claims 11 and 17, respectively, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn for at least the same reasons. Claims 14 and 21 have been amended to be consistent with the amendments to base claims 11 and 17.

Claims 15-16 and 22-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Knight, Henrick and Biliris. As explained above neither Knight, Henrick, or Biliris alone or in any combination teach, suggest or otherwise make obvious each and every limitation of independent Claims 11 and 17 (including interpolating missing information, i.e., an e-mail address, by constructing and verifying potential e-mail addresses).

Since claims 15-16 and 22-23 depend from independent claims 11 and 17, respectively, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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